

Application Serial No. 09/998,321
Attorney Docket No. 7040.0112.00
Amendment—Filed October 1, 2003

REMARKS/ARGUMENTS

Applicants submit this Amendment, together with a Petition for Extension of Time, in reply to the Office Action mailed April 3, 2003.

In this Amendment, Applicants amend two paragraphs in the specification to improve clarity. Applicants also cancel, without prejudice or disclaimer, claim 1. Additionally, Applicants amend Figs. 5 and 6.

Before entry of this Amendment, claims 1 and 25-40 were pending in this application. After entry of this Amendment, claims 25-40 are pending in this application.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to the specification and Figs. 5 and 6. No new matter was introduced.

In the Office Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,311,985 to Gee et al. ("Gee"); rejected claims 37-40 under 35 U.S.C. § 103(a) as being unpatentable over Gee in view of U.S. Patent No. 6,101,870 to Kato et al. ("Kato"); and allowed claims 25-36.

Applicants respectfully traverse the Examiner's rejections.

Allowed Claims

Applicants gratefully acknowledge the Examiner's statement that claims 25-36 are allowed.

Applicants understand the Examiner's statement that "[t]he cited prior art does not disclose or suggest the structural arrangement of the first, second, and fourth device being housed in a container inserted into a wall of the inner tube in a radially-inner position of the inner tube with respect to the at least one wheel" to mean that the cited prior art does not disclose or

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suggest the structural arrangement of three devices housed in a container inserted into a wall of the inner tube in a radially-inner position of the inner tube with respect to the wheel or the at least one wheel, wherein the three devices comprise: (1) a device for measuring at least one status parameter associated with the wheel or the at least one wheel; (2) a device for transmitting a signal indicating a value measured by the device for measuring, wherein the device for transmitting comprises a battery; and (3) a device for sensing movement of the wheel or the at least one wheel and for enabling energization of the device for transmitting when the wheel or the at least one wheel is moving.

Drawings

The drawing corrections include one (1) Replacement Sheet (Figs. 5 and 6) and one (1) Annotated Marked-up Drawings (Figs. 5 and 6). The drawing corrections add reference characters to Fig. 5 (two instances of "100" and three instances of "105") and also improve the readability of reference characters in Fig. 6 (two instances of "115").

Benefit of Prior-Filed Applications

In the Preliminary Amendment filed December 3, 2001, Applicants claimed the benefit under 35 U.S.C. § 120 based on parent International Patent Application No. PCT/EP00/04717, filed May 24, 2000, in the European Patent Office. Applicants also claimed the right of priority under 35 U.S.C. § 119(a) - (d) based on patent application No. 99110608.9, filed June 2, 1999, in the European Patent Office, and patent application No. 00108606.5, filed April 20, 2000, in the European Patent Office. Additionally, Applicants claimed the benefit under 35 U.S.C. § 119(e) based on prior-filed, copending provisional application No. 60/147,476, filed June 14, 1999, in the U.S. Patent and Trademark Office ("USPTO").

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Although the Office Action acknowledges Applicants' claim to the right of priority under 35 U.S.C. § 119(a) - (d), it does not acknowledge Applicants' claims to benefit under either 35 U.S.C. § 120 or 35 U.S.C. § 119(e). Applicants respectfully request that the Examiner expressly acknowledge both of Applicants' claims to benefit in the next paper mailed from the USPTO.

Section 102(b) Rejections—Independent Claim 1

Applicants cancel, without prejudice or disclaimer, claim 1.

Applicants submit that this cancellation obviates the Examiner's rejection of claim 1 under Section 102(b).

Rejections Under 35 U.S.C. § 103(a)—Independent Claim 37

Applicants submit that independent claim 37 is patentable under 35 U.S.C. § 103(a) over the cited references, including Gee, Kato, and the other art of record. This is true whether such art is considered alone or in any proper combination.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a) using multiple references, each of three requirements must be met. First, the references, when combined, must teach or suggest all the claim limitations. M.P.E.P. 2143.03 (8th ed., Rev. 1, Feb. 2003). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. M.P.E.P. 2143.01 (8th ed., Rev. 1, Feb. 2003). Third, there must be a reasonable expectation of success that the proposed combination will work for the intended purpose. M.P.E.P. 2143.02 (8th ed., Rev. 1, Feb. 2003). Moreover, the second and

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third requirements “must both be found in the prior art, not in applicant’s disclosure.” M.P.E.P. 2143 (8th ed., Rev. 1, Feb. 2003).

However, neither Gee, Kato, nor the other art of record, either alone or in any proper combination, teaches or suggests all the limitations of independent claim 37, including at least “wherein the first device, the second device, and the third device are housed in a container, and wherein the container is inserted into the rim from an outside of the rim by screwing the container into a threaded bushing.”

In Gee, for example, transmitter/switch package 18 is interior to rim 12A, while battery 48 is exterior to rim 12A. Thus, transmitter/switch package 18 and battery 48 are not even housed in a container. In Kato, for example, case 2 is inside wheel rim 1 and case 2 is not inserted into wheel rim 1.

For at least these reasons, independent claim 37 is patentable under 35 U.S.C. § 103(a) over the cited references, including Gee, Kato, and the other art of record.

Rejections Under Section 103(a)—Dependent Claims 38-40

Applicants submit that dependent claims 38-40 are patentable under 35 U.S.C. § 103(a) over the cited references, including Gee, Kato, and the other art of record. This is true at least due to the direct dependency of claims 38-40 from independent claim 37.

Claim Scope

In discussing the specification, claims, abstract, and drawings of the present application in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that Applicants are entitled to have the

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claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this Application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: October 1, 2003

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